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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,360	09/04/2001	Teruaki Sekine	2001_1248A	1329

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EXAMINER

DAVIS, MINH TAM B

ART UNIT PAPER NUMBER

1642

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,360

Applicant(s)

SEKINE ET AL.

Examiner

MINH-TAM DAVIS

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant cancels claims 1-23 and adds new claims 24-29 which are related to prior claims 1-4, 7-21 and are not new matter

Accordingly, claims 24-29 are being examined.

The following are the remaining rejections.

REJECTION UNDER 35 USC 103

Rejection under 35 USC 103 of claims 24-29 pertaining to obviousness over Sekine et al, in view of Chakravarty, A et al, remains for reasons already of record in paper No.9 of 03/13/03.

Applicant submits a Declaration by T. Sekine and T. Takayama, stating that the coauthors of the reference by Takayama, T. et al are merely working under their direction and control.

Applicant asserts that thus the reference by Takayama, T et al should be removed from the 103 rejection.

Applicant further asserts that Sekine et al merely describes protocols and initial data from a clinical trial and one would not expect that it could be possible to prevent recurrence of liver cancer for five years, by administering to a cancer patient activated lymphocytes.

The submission of the Declaration by T. Sekine and T. Takayama is acknowledged.

Applicant's arguments set forth in the response of 08/13/03 and 10/30/03 have been considered but are not deemed to be persuasive for the following reasons:

Rejection remains, even with the omission of the reference by T Takayama.

It is noted that the translated reference by Sekine et al is enclosed therewith.

Sekine et al teach treating patients having hepatocellular carcinoma after curative resection with activated lymphocytes, with a dose of about 1 to 3×10^{10} activated lymphocytes, which are the same reagents, i.e. activated lymphocytes, used in the claimed method (abstract). Sekine et al further teach that recurring-free survival rates up to 24 months from 49 treated patients with hepatocellular carcinoma, with a recurrence in 13 cases of 49 treated patients (p.5-6 and figure 3 on p.7).

Although Sekine et al do not teach that the prevention of recurrence of liver cancer for five years, one would have expected that the same result would be obtained with the method of Sekine et al, because the method taught by Sekine et al seems to be the same as the claimed method.

Further, although Sekine et al do not teach that the treatment is performed while performing surgical treatment of liver cancer, it would have been obvious to do so, because one would have expected that the same result would be obtained with the method of Sekine et al, wherein treatment with activated lymphocytes is complementary to surgery.

The reference does not specifically teach that the prevention of recurrence of liver cancer for five years. However, the claimed therapeutic method appears to be the same as the prior art therapeutic method, absent a showing of unobvious differences. The office does not have the facilities and resources to provide the factual evidence needed in order to establish that the method of the prior art does not possess the same characteristics of the claimed method. In the absence of evidence to the contrary, the burden is on the applicant to prove that the claimed method is different from those taught by the prior art and to establish patentable differences. See *In re Best* 562F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd. Pat. App. & Int. 1989).

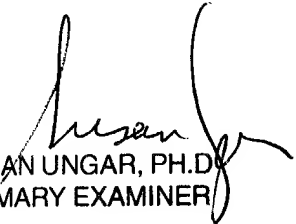
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.


SUSAN UNGAR, PH.D.
PRIMARY EXAMINER

MINH TAM DAVIS

November 26, 2003